

**REMARKS/ARGUMENTS**

Claims 1-15 are pending in the present application. In the Office Action mailed April 21, 2006, the Examiner rejected claims 1, 3, 5-7, 13 and 15 under 35 U.S.C. § 102. The Examiner also rejected claims 2, 4-6, 8-12 and 14 under 35 U.S.C. § 103.

Reconsideration is respectfully requested in view of the above amendments to the claims and the following remarks.

**A. Specification**

The specification has been amended to address the Office Action's objections to the specification.

**B. Objections to Claims 1-15**

The Office Action objected to claims 1-15 because of informalities contained in claims 1, 8, 13, and 15. Specifically, the Office Action asserts that “[C]laim 1 recites, ‘to receive new data...to update the adapter’ in lines 9-10. It appears that applicant meant to recite ‘to receive new data...to update a program of the adapter.’” Office Action, page 2. In response to the suggestion provided in the Office Action, claim 1 has been amended to recite “to receive new data...to update a program of the adapter.” Similar amendments have been made to claims 8, 13, and 15 pursuant to the suggestion provided in the Office Action. Withdrawal of this objection is respectfully requested.

**C. Claims 1, 3, 5-7, 13 and 15 Rejected Under 35 U.S.C. § 102(a)/102(e)**

The Examiner rejected claims 1, 3, 5-7, 13 and 15 under 35 U.S.C. § 102(a)/102(e) as being anticipated by U.S. Patent No. 6,074,434 to Cole et al. (hereinafter, “Cole”). This rejection is respectfully traversed.

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” MPEP § 2131 (citing Verdegaal Bros. v. Union Oil Co. of California, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)). “The identical

invention must be shown in as complete detail as is contained in the ... claim." Id. (citing Richardson v. Suzuki Motor Co., 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)). In addition, "the reference must be enabling and describe the applicant's claimed invention sufficiently to have placed it in possession of a person of ordinary skill in the field of the invention." In re Paulsen, 31 USPQ2d 1671, 1673 (Fed. Cir. 1994).

Applicants respectfully submit that the claims at issue are patentably distinct from Cole. Cole does not disclose all of the limitations in these claims.

Claims 1 has been amended to recite, "communications hardware for communicating automatically with the provider computer through the communications network." Support for this amendment may be found in Applicants' specification, page 9, lines 15-17. Cole does not disclose this limitation. Instead, Cole discloses, "A user at client computer 14 selects an icon to invoke update manager 32." Cole, Col. 3, lines 62-64. A user selecting an icon to invoke update manager is not "communicating automatically with the provider computer through the communications network." Cole further discloses,

"In response [to the user selecting an icon] the update manager contacts the general manager 31 in server 12 to begin a session and supplies the current level of update manager 32, scout 33, service application 34 and download routine 39 within the client 14 (step 104)."

Cole, col. 3, lines 64-67 – col. 4, line 1.

Contacting the general manager in a server in response to the user selecting an icon does not disclose "communicating automatically with the provider computer." As such, Cole does not disclose a communications adapter comprising "communications hardware for communicating automatically with the provider computer."

In addition, claim 1 recites "wherein the new data comprises device instructions for the processor for communicating with the electronic device through the communications port." Cole does not disclose this limitation. Instead, Cole discloses:

In this example, the BIOS level 123, BIOS date Jan. 1, 1996 and mother board ID XYZ basic system information obtained from client

14 is consistent with a device driver file named ABCDE.DRV. and Netcomber (trademark of International Business Machines Corporation) version 2.0.

Cole, Col. 5, lines 13-17.

A device driver file is not “device instructions for the processor for communicating with the electronic device through the communications port.” Cole classifies the device driver file and the Netcomber as “code updates.” Cole, Col. 5, line 22. Code updates are not instructions for communicating with the electronic device. Rather, Cole discloses:

1. minimum number of code updates – code updates which are necessary for the client to ensure compatibility between programs within the client and fix a significant “bug” in a program within the client, and those other updates that the author of the code update deemed critical such as replacement of unsupported programs.

Cole, Col. 6, lines 61-67 (emphasis added).

Code updates that ensure the compatibility between programs within the client are not “device instructions for the processor for communicating with the electronic device.” Similarly, code updates that fix a significant “bug” in a program within the client are not “device instructions...for communicating with the electronic device.” Code updates used for the replacement of unsupported programs are not “device instructions...for communicating with the electronic device.” Cole does not disclose that the code updates are to be used as instructions for communicating with the electronic device. Instead, the code updates are to be used to fix programs, replace programs, and ensure compatibility between programs within the client.

In view of the foregoing, Applicants respectfully submit that claim 1 is patentably distinct from Cole. Accordingly, Applicants respectfully request that the rejection of claim 1 be withdrawn.

Claims 3 and 5-7 depend either directly or indirectly from claim 1. Accordingly, Applicants respectfully request that the rejection of claims 3 and 5-7 be withdrawn for at least the same reasons as those presented above in connection with claim 1.

Claim 13 has also been amended to recite, “communications hardware for communicating automatically with a provider computer through a communications network.” Support for this amendment may be found in Applicants’ specification, page 9, lines 15-17. As previously explained with reference to claim 1, Cole does not disclose this limitation.

In addition, claim 13 recites “communicating with the electronic device using the new instructions.” Cole does not disclose this limitation. Cole discloses, “[u]sing this FTP addressing information, the download routine 39 of the client downloads the code updates from the content server 17 (step 133).” Cole, Col. 7, lines 13-15. Cole does not disclose these code updates are for “communicating with the electronic device using the new instructions.” Instead, Cole discloses the following regarding the use of the code updates:

1. minimum number of code updates – code updates which are necessary for the client to ensure compatibility between programs within the client and fix a significant “bug” in a program within the client, and those other updates that the author of the code update deemed critical such as replacement of unsupported programs.

Cole, Col. 6, lines 61-67 (emphasis added).

Cole does not disclose that the code updates are used to communicate with the electronic device. Ensuring compatibility between programs within the client is not “communicating with the electronic device using the new instructions.” Fixing a significant “bug” in a program within the client is not “communicating with the electronic device using the new instructions.” Similarly, using the code updates to replace unsupported programs is not “communicating with the electronic device using the new instructions.”

In view of the foregoing, Applicants respectfully submit that claim 13 is patentably distinct from Cole. Accordingly, Applicants respectfully request that the rejection of claim 13 be withdrawn.

Claim 15 has also been amended to recite, “means for communicating automatically with the provider computer through the communications network.” Support for this amendment may also be found in Applicants’ specification, page 9, lines 15-17. As previously explained with reference to claim 1, Cole does not disclose this limitation.

In addition, claim 15 recites “wherein the new instructions are executable by the means for processing for communicating with the electronic device without altering any program code on the electronic device. Cole does not disclose this limitation. Instead, Cole discloses:

1. minimum number of code updates – code updates which are necessary for the client to ensure compatibility between programs within the client and fix a significant “bug” in a program within the client, and those other updates that the author of the code update deemed critical such as replacement of unsupported programs.

Cole, Col. 6, lines 61-67 (emphasis added).

Code updates being used to ensure compatibility between programs within the client is not “new instructions...for communicating with the electronic device.” Code updates being used to fix a significant “bug” in a program within the client is not “new instructions...for communicating with the electronic device.” Similarly, code updates being used to replace unsupported programs is not “new instructions...for communicating with the electronic device.”

In view of the foregoing, Applicants respectfully submit that claim 15 is patentably distinct from Cole. Accordingly, Applicants respectfully request that the rejection of claim 15 be withdrawn.

#### **D. Rejection of Claims 2, 4-6, 8-12 and 14 Under 35 U.S.C. § 103(a)**

The Examiner rejected claims 2, 4-6, 8-12 and 14 under 35 U.S.C. § 103(a) based on Cole. This rejection is respectfully traversed.

The M.P.E.P. states that

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in

the prior art, and not based on applicant's disclosure.

The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.

M.P.E.P. § 2142.

Applicants respectfully submit that the claims at issue are patentably distinct from the cited reference. The cited reference does not teach or suggest all of the limitations in these claims.

Claim 8 has been amended to recite, “communications hardware for communicating automatically with the provider computer through the communications network.” Support for this amendment may be found in Applicants’ specification, page 9, lines 15-17. Cole does not disclose this limitation. Instead, Cole discloses, “A user at client computer 14 selects an icon to invoke update manager 32.” Cole, Col. 3, lines 62-64. A user selecting an icon to invoke update manager is not “communicating automatically with the provider computer through the communications network.” As Cole further discloses,

“In response [to the user selecting an icon] the update manager contacts the general manager 31 in server 12 to begin a session and supplies the current level of update manager 32, scout 33, service application 34 and download routine 39 within the client 14 (step 104).”

Cole, col. 3, lines 64-67 – col. 4, line 1.

Contacting the general manager in a server in response to the user selecting an icon does not disclose “communicating automatically with the provider computer.” As such, Cole does not disclose a communications adapter comprising communications hardware for communicating automatically with the provider computer.

In addition, claim 8 recites “wherein the new instructions are executable by the processor for communicating with the electronic device through the communications port without altering any

program code on the electronic device.” Cole does not teach or suggest this claim limitation. Cole teaches “For each code update, such as device driver file...” Cole, Col. 5, line 22. As such, Cole suggests that a device driver file is a code update. Code does not teach or suggest that such code updates are used for “communicating with the electronic device.” Instead, Cole teaches:

1. minimum number of code updates – code updates which are necessary for the client to ensure compatibility between programs within the client and fix a significant “bug” in a program within the client, and those other updates that the author of the code update deemed critical such as replacement of unsupported programs.

Cole, Col. 6, lines 61-67 (emphasis added).

Code updates being used to ensure compatibility between programs within the client does not teach or suggest “new instructions...for communicating with the electronic device.” Code updates being used to fix a significant “bug” in a program within the client does not teach or suggest “new instructions...for communicating with the electronic device.” Similarly, using code updates as a replacement of unsupported programs does not teach or suggest “new instructions...for communicating with the electronic device.”

In view of the foregoing, Applicants respectfully submit that claim 8 is patentably distinct from the cited references. Accordingly, Applicants respectfully request that the rejection of claim 8 be withdrawn.

Claims 9-12 depend either directly or indirectly from claim 8. Accordingly, Applicants respectfully request that the rejection of claims 9-12 be withdrawn for at least the same reasons as those presented above in connection with claim 8.

In the present case, claims 2 and 4-6 depend from claim 1 and therefore include all the limitations of this independent claim such as “wherein the new data comprises device instructions for the processor for communicating with the electronic device through the communications port.” As previously explained, such limitation is not disclosed in Cole. Accordingly, because Cole does not teach or suggest all of the limitations found in claims 2 and 4-6, this reference does not render the

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present claims prima facie obvious under 35 U.S.C. § 103(a). Applicants respectfully request that the rejection of claims 2 and 4-6 be withdrawn.

In the present case, claim 14 depends from claim 13 and therefore includes all the limitations of this independent claim such as “communicating with the electronic device using the new instructions.” As previously explained, such limitation is not disclosed in Cole. Accordingly, because Cole does not teach or suggest all of the limitations found in claim 14, this reference does not render the present claims prima facie obvious under 35 U.S.C. § 103(a). Applicants respectfully request that the rejection of claims 2 and 4-6 be withdrawn.

**E. Double Patenting Rejection of Claims 1-15**

The Office Action rejected claims 1-15 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over U.S. Patent Nos. 6,954,850 and 6,728,804 issued to Michael L. Howard et al. The Office Action also rejected claims 1-15 under the doctrine of obviousness-type double patenting as being unpatentable over U.S. Application No. 11/176,140 by Michael L. Howard et al. Applicant herewith files a terminal disclaimer in compliance with 37 C.F.R. § 1.321(c) to overcome this rejection. The terminal disclaimer is enclosed.

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**F. Conclusion**

Applicants respectfully assert that all pending claims are patentably distinct from the cited references, and request that a timely Notice of Allowance be issued in this case. If there are any remaining issues preventing allowance of the pending claims that may be clarified by telephone, the Examiner is requested to call the undersigned.

Respectfully submitted,



/Wesley L. Austin/

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Wesley L. Austin  
Reg. No. 42,273  
Attorney for Applicant

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MADSON & AUSTIN  
Gateway Tower West  
15 West South Temple, Suite 900  
Salt Lake City, Utah 84101  
Telephone: 801/537-1700